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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,170	08/05/2003	Jiing-Yang Wu	08415-005001	6339

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EXAMINER

MAHAFKEY, KELLY J

ART UNIT	PAPER NUMBER
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1761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/634,170

Applicant(s)

WU ET AL.

Examiner

Kelly Mahafkey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/4/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION

Amendments made December 4, 2006 have been entered.

Claims 1-14 and 16-21 are pending.

Specification

The objection to the specification has been withdrawn in light of applicant's amendments made December 4, 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 and 16-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material, in claims 1 and 16, that is not supported by the original disclosure is as follows: providing a plurality of uncooked materials... grinding the uncooked materials. Although the specification, as originally filled, has support for cooking the ground materials, the specification does not have support for uncooked materials. Applicant states that the term "uncooked materials" is supported because the specification teaches of cooking the materials, however, because a food is later cooked does not mean that it was raw prior to the recited cooking step.

Note: The previous 112 second paragraph rejection of claims 4 and 14 has been withdrawn in light of applicant's amendments filed December 4, 2006.

Claim Rejections - 35 USC § 102

The 102(b) rejection of claims 1-5, 7, and 14 as being anticipated by Rockland et al. (US 4124727) has been withdrawn in light of applicant's amendments filed December 4, 2006.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.


The rejection of claims 6, 8, and 9 over Rockland in view of Igoe (Dictionary of Food Ingredients) has been withdrawn in light of applicant's amendments made December 4, 2006.

The rejection of claim 10 over Rockland further in view of Oplinger et al. (Alternative Field Crops Manual) has been withdrawn in light of applicant's amendments made December 4, 2006.

The rejection of claim 11 over Rockland in view of Duke (*Coix lacryma-jobi* L.) has been withdrawn in light of applicant's amendments made December 4, 2006.

The rejection of claims 12 and 13 over Rockland in view of Murray (Rice bran may lower cholesterol) has been withdrawn in light of applicant's amendments made December 4, 2006.

The rejection of claim 21 over Rockland in view of Sadel, further in view of Igoe (Dictionary of Food Ingredients) has been withdrawn in light of applicant's amendments made December 4, 2006.

Claims 1-14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockland et al. (US 4124727) in view of the combination of Kon et al. (US 4084016) and Lazarus (US 4965081). 

Rockland et al. (Rockland) teaches of an extruded reconstituted grain product manufactured by reconstituting a ground material, wherein the ground material comprises a plurality of grains including wheat, oat, rice, and barley and legumes including soybeans, having various respective cooking requirements. Rockland teaches

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that texture modifiers, such as emulsifiers (i.e. gum) can be added to the composition. Refer specifically to Abstract, Column 2 lines 56-60, Column 4 lines 55-66, Column 6 lines 11-21 and 46-55, and Column 7 lines 14-20. In Example 2, Rockland teaches the grains of the ground material, with the exclusion of the rice, (i.e. wheat flour) is between 1-50% by weight of the ground material and that the rice is about 25% weight of the ground material. Rockland, Examples 1 and 2 and Column 4 lines 55-65, teaches of grounding the legumes to a mesh size of around 100 mesh and utilizing rice flour (i.e. ground rice). Note: As demonstrated by Ingredients 101, rice flour has a particle size of 50-100 mesh. Thus, Rockland teaches of grinding the grains to a particle size within the recited range. Rockland, Column 5 lines 22-41, teaches that the ground material is mixed, combined with water, extruded, and formed into a desired final shape. Rockland, Column 5 lines 60-65, teaches that the formed product is then dehydrated by frying.

Rockland, however, is silent to the product as dehydrated without frying, such as drying at 45-50C for 3-4 hours as recited in claim 1, to the ground material as uncooked as recited in claim 1, and to the optional limitations as recited in claims 8-13 and 21. Regarding the product as dehydrated without frying, such as drying at 45-50C for 3-4 hours as recited in claim 1, Kon teaches that legume chips, such as the one taught by Rockland, can be dehydrated by frying, or by partial dehydration from exposure to heat and then frying, or by dehydration without frying. Kon teaches the benefits of only drying (i.e. and not frying) the chip is that a lower fat food product is produced. Refer specifically to Column 3 lines 40-48. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce the extruded legume chip product as taught by Rockland with drying as the dehydration step in view of Kon. One would have been motivated to do so in order to produce a product which was lower in fat. Lazarus teaches of an extruded chip product that is dehydrated by drying equipment or by laying out at room temperature until the desired moisture content is achieved (Abstract and Column 4 lines 23-40). It would have been further obvious to one of ordinary skill in the art at the time the invention was made to dry the extruded chip product as taught by Rockland at a specific temperature and for an amount of time

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depending on the equipment available, the length of time available for drying, and the desired moisture content of the final food product. Furthermore, claim 1 is directed to a product and applicant is reminded, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). "The lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). Thus, absent any clear and/or convincing arguments to the contrary, the references anticipate the limitation of drying the extruded product.

Regarding the optional limitations as recited in claims 8-13 and 21. Due to the optional limitations recited in claim 4, the inclusion of 17.5% barley in the reconstituted product (the current option) recited in dependent claim 8 is not a required limitation, and thus claim 8 is also included in the rejection. Claims 9-13 and 21 are also optional limitations which are rejected for the same reasons that claim 8 is rejected.

Regarding the ground material as uncooked as recited in claim 21, Rockland teaches of first cooking the material before grinding. Applicant is reminded, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

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product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). One of ordinary skill in the art at the time the invention was made would expect a product which was formed from cooked ground material or uncooked ground material, which was then extruded, dried, and cooked to result in a similar end product absent any clear or convincing arguments to the contrary.

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockland in view Sadel, Jr. et al. (US 4778690). The references and rejection are incorporated herein and as cited in the office action mailed September 1, 2006.

Regarding the additional limitation, of grinding uncooked material, as added by applicant's amendments made December 4, 2006, Rockland teaches that the ground material is cooked prior to grinding. It was known in the art to grind cooked and/or uncooked grains depending on the intended use of the resulting ground paste and the ingredients to be ground. To ground either cooked or uncooked ingredients in the method as taught by Rockland would not involved an inventive step or contribute a patentable distinction to the claims.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rockland in view of Sadel as applied to claims 16-19 above, and further in view of Igoe (Dictionary of Food Ingredients). The references and rejection are incorporated herein and as cited in the office action mailed September 1, 2006.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection, as necessitated by applicant's amendments made December 4, 2006.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Mahafkey
Examiner
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KEITH HENDRICKS
PRIMARY EXAMINER